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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/768,748	01/24/2001	Raghu Sharma	285.0021 0101	3864
26813	7590	02/18/2005		EXAMINER
MUETING, RAASCH & GEBHARDT, P.A. P.O. BOX 581415 MINNEAPOLIS, MN 55458			TON, DANG T	
			ART UNIT	PAPER NUMBER
			2666	

DATE MAILED: 02/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/768,748	SHARMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	DANG T TON	2666	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

**A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 24 January 2001.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-86 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>4 and 7-12</u> | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____                                    |

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1. Claims 2-3, 12-15, and 36-38 are objected to under 37 C.F.R 1.75 because of the following formalities:

In claim 2 line 13, and claim 3 line 10, " a remote location " seems to refer back to " a remote location " recited in claim 1 line 13. If this is true, it is suggested to change " a remote location " to --- the remote location ". the same is true with the term " a local user " recited in claim 12 and 36.

Claims 13-15 and 37-38 are objected since they depend from claims 12 or 36.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-86 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-11 of U.S. Patent No. 5,452,289 in

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view of ( Duran et al. ( 6,181,784) and Hyde-Thomson ( 5,717,742) ).

For claims 1-86, the claims 1-11 of the patent number 5,452,289 disclose multifunction communication system for use with a personal computer, the personal computer having a processor, memory, and a peripheral data store, comprising:

a communications module connected to the personal computer,

the module comprising:

communications interface means connected for communicating to the personal computer for transferring data between the personal computer and the communications module;

telephone line interface means for connection to a telephone line and for full duplex digital communication over the telephone line;

telephone voice interface means for receiving local voice signals from a local user and for conveying remote voice signals from a remote user to the local user;

full-duplex conversion means for converting the local voice signals into outgoing digital voice data and for converting incoming digital voice data into the remote voice signals;

compression means for compressing the outgoing digital voice data into compressed outgoing digital voice data packets and for decompressing compressed incoming digital voice data packets into the incoming digital voice data, each of the compressed outgoing digital voice data packets having headers and each of the compressed incoming digital voice data packets having headers;

main control means for receiving the compressed outgoing digital voice data packets from the compression means, for receiving outgoing computer digital data packets from the personal computer through the communications interface means, for multiplexing the compressed outgoing digital voice data packets and the outgoing computer digital data packets to produce multiplexed outgoing digital data and for sending the multiplexed outgoing digital data to the telephone line interface means for digital transmission over the telephone line;

the main control means further for receiving multiplexed incoming digital data from the telephone line interface means from the telephone line, the multiplexed incoming digital data containing incoming computer digital data packets multiplexed with the compressed incoming digital voice data packets, for demultiplexing the incoming computer digital data packets and the compressed incoming digital voice data packets, and for sending the incoming computer digital data packets to the personal computer through the communications interface means and for sending the compressed incoming digital voice data packets to the compression means, each of the incoming computer digital data packets having headers;

the personal computer operable for executing software to communicate with the communications module through the communications interface and operable for initiating a telephone call to a remote site in response to the commands by the local user and for causing the main control means of the communications module to perform multiplexing and demultiplexing; and

the personal computer further operable for receiving and storing the incoming computer digital data packets received from the communications module over the communications interface and for transmitting the outgoing computer digital data packets to the communications module over the communications interface ;

wherein the communications module further includes acoustic echo cancellation means for removing at least a portion of the incoming digital voice data from the outgoing digital voice data for acoustic echo cancellation;

wherein the communications module further includes line echo cancellation means for removing at least a portion of the outgoing digital voice data from the incoming digital voice data for line echo cancellation;

wherein the main control means is further operable for receiving incoming fax data from the telephone line through the telephone line interface means and forwarding the incoming fax data to the personal computer through the communications interface means and for receiving outgoing fax data from the personal computer through the communications interface means and

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sending the outgoing fax data to the telephone line through the telephone line interface means ;

wherein the communications interface means is connected for communicating to a communications port of the personal computer for transferring data between the personal computer and the communications module ;

wherein the communications interface means is connected for communicating directly to a bus of the personal computer for transferring data between the personal computer and the communications module ;

wherein the main control means is further operable for receiving the compressed outgoing digital voice data packets from the compression means and for forwarding the compressed outgoing digital voice data packets to the personal computer; and

the personal computer is further operable for receiving and storing the compressed outgoing digital voice data packets received from the communications module over the communications

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interface and for storing the compressed outgoing digital voice data on the peripheral data store ;

wherein the main control means is further operable for receiving the compressed incoming digital voice data packets and for forwarding the compressed incoming digital voice data packets to the personal computer; and

the personal computer is further operable for receiving and storing the compressed incoming digital voice data packets received from the communications module over the communications interface and for storing the compressed outgoing digital voice data on the peripheral data store ;

wherein the personal computer is further operable for retrieving the compressed incoming digital voice data from the peripheral data store, for modifying the compressed incoming digital voice data to create modified compressed incoming digital voice data and for storing the modified compressed incoming digital voice data onto the peripheral data store ;

wherein the telephone line is an analog telephone line and the telephone line interface means is further operable for

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modulating the multiplexed outgoing digital data into a modulated analog signal for full duplex digital communication ; and

wherein the telephone line is a digital telephone line and the telephone line interface means is further operable for sending the multiplexed outgoing digital data over the telephone line as unmodulated digital data for full duplex digital communication.

(Note : see claims 1-11 of the patent).

Applicant's claims 1-86 merely broaden the scope of the patent number 5,452,289 claims 1-11 by eliminating the terms " communications interface means connected for communicating to the personal computer for transferring data between the personal computer and the communications module " ; " telephone voice interface means for receiving local voice signals from a local user and for conveying remote voice signals from a remote user to the local user" ; " full-duplex conversion means" ;

" compression means for compressing the outgoing digital voice data into compressed outgoing digital voice data packets and for decompressing compressed incoming digital voice data packets

into the incoming digital voice data, each of the compressed outgoing digital voice data packets having headers and each of the compressed incoming digital voice data packets having headers " ; " main control means for receiving the compressed outgoing digital voice data packets from the compression means, for receiving outgoing computer digital data packets from the personal computer through the communications interface means" ; the main control means further for receiving multiplexed incoming digital data from the telephone line interface means from the telephone line, the multiplexed incoming digital data containing incoming computer digital data packets multiplexed with the compressed incoming digital voice data packets, for demultiplexing the incoming computer digital data packets and the compressed incoming digital voice data packets, and for sending the incoming computer digital data packets to the personal computer through the communications interface means and for sending the compressed incoming digital voice data packets to the compression means, each of the incoming computer digital data packets having headers " and ; " the personal computer operable for executing software to communicate with the communications module through the

communications interface and operable for initiating a telephone call to a remote site in response to the commands by the local user and for causing the main control means of the communications module to perform multiplexing and demultiplexing " from claim 1 of the patent. It has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re karlson, 136 USPQ 184 (CCPA). Also note Ex Parte Raine, 168 USPQ 375 (bd. App. 1969); omission of a reference element whose function is not need would be obvious to one skilled in the art.

For claims 1-86, the claims 1-11 of the patent disclose all the subject matter of the claimed invention with the exception of using multimedia mail as recited in claims 1-3, 6-8, 11-16, 19-20, 22, 24-27, 30-32, 34-40, 43-46, 48-51, 55-61, 63-64, 67-72, 74, 77-78, and 80-82 in a communications network and display, playback, deletion, textual information in a communications network as recited in claims 4, 5, 9, 10, 17, 18, 21, 23, 28, 29, 33, 41, 42, 47, 52, 53, 54, 62, 65, 66, 73, 75, 76, 79, 83, 84, 85, and 86. Hyde-Thomson from the same or similar fields of endeavor teaches a provision of the media mail and the display, playback, deletion, graphical information and textual

information (see box 2 in figure 1 and box 24 in figure 1). Thus, it would have been obvious to the person of ordinary skill in the art at the time of the invention to use the display, playback, deletion, graphical information and textual information and the media mail as taught by Hype-Thomson in the communications network of the claims 1-11 of the patent.

The display, playback, deletion, graphical information and textual information and the media mail can be implemented/modified into the network of the claims 1-11 of the patent since the claims 1-11 of the patent does teach using the combining the outgoing data and the communication modules. The motivation for using the display, playback, deletion, graphical information and textual information and the media mail as taught by Hype-Thomson into the communications network of the claims 1-11 of the patent being that it provides a system for sending and retrieving both voice and text message over the computer network.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Duran et al. ( 6,181,784) is cited to show a system which is considered pertinent to the claimed invention.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANG T TON whose telephone number is 571-272-3171. The examiner can normally be reached on MON-WED, 5:30 AM-6:00 PM and Thur 5:30-9:30 A.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, RAO SEEMA can be reached on 571-272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Ton

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DUGAN  
PRIMARY EXAMINER